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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/008,941	11/08/2001	Satoru Tachihara	001085.098263	6391

7590 10/21/2003
PITNEY, HARDIN, KIPP & SZUCH LLP
711 Third Avenue
New York, NY 10017

EXAMINER

FINEMAN, LEE A

ART UNIT	PAPER NUMBER
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2872

DATE MAILED: 10/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/008,941

Applicant(s)

TACHIHARA ET AL.

Examiner

Lee Fineman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13 and 14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
 - 2) ☒ Certified copies of the priority documents have been received in Application No. 09/584943.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

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DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 17 July 2003 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kitajima et al., U.S. Patent No. 5,015,081 in view of Mochizuki et al., U.S. Patent No. 5,825,532 and Muchel, U.S. Patent No. 4,525,042.

Kitajima et al. discloses a stereoscopic microscope (figs. 1-3) comprising a common close-up optical system (10) that faces an object (6) and has one and only one optical axis (36); a pair of imaging optical systems (12, 14, 16, 18) that take object light rays passing through the different region of the close-up optical system, respectively, to form a pair of images, the optical axes of the imaging optical systems (34) being parallel to the optical axis of the close-up optical system; the imaging system comprising a pair of zoom optical systems (12) that take object light rays passing through different region of the close-up optical system, respectively, to form a pair

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of primary images, the optical axes of the zoom optical systems (34) being parallel to the optical axis of the close-up optical system; a pair of field stops (14) that are arranged at the positions of the primary image; a pair of relay optical systems (18) that relay the primary images to form a pair of secondary images. Kitajima et al. lacks an image taking device that captures the images formed on an image taking surface thereof, an inter-axis device reducing element that brings the object light rays from said relay optical systems close to each other, and wherein the close-up optical system satisfies the following condition $f_A > 500$ where f_A is a focal length (units: mm) of the close-up optical system. Mochizuki et al. teaches an imaging system optical adaptor (fig. 2) for a stereoscopic microscope with an image taking device that captures the images formed on an image taking surface thereof (3) and an inter-axis device reducing element that brings the object light rays from said relay optical systems close to each other (209). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the microscope of Kitajima et al. to include the imaging system optical adaptor of Mochizuki et al. to be able to record the images. Lens or lens groups are very well known in the art for providing many different focal lengths including ones greater than 500 mm. For example, Muchel has a system with single or grouped lenses that provide variable focus lengths of 57 to 1000 mm (fig. 2). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the close-up optical system of Kitajima et al. have any focal length, including lengths greater than 500 mm, to provide a specific working distance.

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Response to Arguments

4. Applicant's arguments filed 17 July 2003 have been fully considered but they are not persuasive.

Applicant argues that Muchel does not disclose a close up optical system having one and only one optical axis that also has a focal length of greater than 500 mm. However, as stated in the above rejection, Muchel suggests that many focal lengths (57-1000 mm, fig. 2) can be used within a microscope to provide different working distances in operation microscopes and therefore does provide a teaching for Kitajima et al. to make its close-up optical system with one and only one optical axis have any focal length including one of greater than 500 mm. The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lee Fineman whose telephone number is (703) 305-5414. The examiner can normally be reached on Monday - Friday 7:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Dunn can be reached on (703) 305-0024. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4900.



LAF
October 14, 2003


MARK A. ROBINSON
PRIMARY EXAMINER